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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/697,272 | 10/31/2003 | Stefek Malkowski Zaba | 200308879-2 | 7911 |

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

WALSH, DANIEL I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,272

Applicant(s)

ZABA ET AL.

Examiner

Daniel I. Walsh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 18 July 2005.
2. The indicated allowability of claims 4 and 9-10 are withdrawn in view of the newly discovered reference(s) (see below). Rejections based on the newly cited reference(s) follow.

Claim Objections

3. Claim 9 is objected to because of the following informalities: Replace "f.", "g.", "h.", "i.", "j." with -- "a.", "b.", "c.", "d.", "e." --. The Examiner notes that the letters appear to follow in sequence with those of claim 8. However, claim 9 is an independent claim, therefore the characters should not follow claim 8 as if a dependent claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arrieta, as cited in the previous Office Action, in view of Azuma (US 6,704,608).

The teachings of Arrieta have been discussed in the previous Office Action. Namely, Arrieta teaches security document comprising a printed document and one or more circuits to be read wirelessly that are incorporated into the document and that the memory circuit is physically isolated so as to inhibit tampering or configured to indicate when tampering has occurred (abstract). Arrieta teaches that the emitter (radio frequency, as per claim 3) is integrated into the hologram. The Examiner interprets the hologram to broadly be interpreted as a tamper evident strip. The Examiner notes that the teachings of Arrieta are interpreted to extend to include those of an identification card, which is listed as a security document (paragraph [0002]). Re claim 5, as the antenna is connected to the IC which is integrated into the substrate, the antenna is therefore interpreted to be configured for detection or resistance of physical tampering.

Arrieta is silent to protecting the memory circuit from access by an unauthorized reader.

Azuma teaches mutual authentication for increased security (abstract). This is interpreted to include protecting access from an unauthorized reader. Re claim 2, Azuma teaches the power is provided from the reader (abstract), or that the card is passive. It would have been obvious to use inductive power means, in order to reduce document cost/size/complexity as is known in the art.

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At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Arrieta with those of Azuma.

One would have been motivated to do this for increased security.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arrieta/Azuma, as discussed above, in view of Habara et al. (US 2003/0136851).

The teachings of Arrieta/Azuma have been discussed above.

Arrieta/Azuma is silent to identifying an authorized bearer of the security document and that the document allows access to asset(s) of the bearer.

Habara et al. teaches the document is used to identify/authenticate an authorized bearer of the document (abstract). Though silent to the document allowing access to asset(s), the Examiner notes that intended use is not patentable. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2n 1647 (1987). Additionally, the Examiner notes that it is well known and conventional in the art for security documents/cards to be presented by a user to verify themselves for access to an area, services, safe deposit boxes, restricted areas, etc. (by presentation of id cards, passports, bank cards, drivers license, etc.). Accordingly, in light of the cited prior art, it would have been obvious that such documents could be provided to authenticate/verify an individual to access assets, as a means for identification.

6. Claims 8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Azuma (US 6,704,608).

Re claim 8, Azuma teaches a printed document (FIG. 1A). The printed document includes printed information and second information for writing to a memory circuit (13) of the printed document. The second information is protected from unauthorized reading as mutual authentication with a reader/terminal (abstract) is required. Mutual authentication is understood to include verifying the document/card and reader, for security purposes. The Examiner notes that though the teachings of Azuma are silent to the creation of the document (printing on the document and writing to the memory circuits), the Examiner notes that it would have been obvious to one of ordinary skill in the art to print first information on the document and write second information into the memory (read wirelessly as shown in FIG. 1A), as such means are well known and conventional in the art to produce a card/document and provide for readable (man) and machine readable information (stored), to provide conventional card/document functionality. The Examiner notes that the circuit/memory is understood to be isolated to inhibit physical tampering/physically located, as it is disposed in one of the layers of the document. Tampering with the memory would also be visibly discernable.

Re claims 11-12, the teachings have been discussed above. The Examiner notes that it would have been obvious to one of ordinary skill in the art to determine information before its printed/written in order to create the card/document, and that circuits are attached in/on the card/document as is conventional in the art to store information. Indicia/information printing on a card/document is well known in order to provide information about the user, manufacturer of the card/document, etc.

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Habara et al. (US 2003/0136851) in view of Azuma, as discussed above.

Habara et al. teaches reading first information printed in the printed document and wirelessly reading second information in a memory circuit and using the second information with the first information to assess the document/compare characteristics of the bearer of the document (abstract and paragraph [0052] which teach comparing the printed identification data to the stored data read out to verify a user).

Habara et al. is silent to obtaining authorization information to read the document, wirelessly powering the document, and reading the second information in the memory circuit using authorization information.

The teachings of Azuma have been discussed above. Azuma teaches powering the document (abstract) and mutual authentication as is understood with mutual authentication, authorization information is obtained, by verifying the reader/(card/document), in order to read the stored information of the security document.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Azuma with those of Habara et al.

One would have been motivated to do this to increase the security associated with card/document information.

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Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The Examiner notes that a security document/printed document is broadly interpreted to include a card.

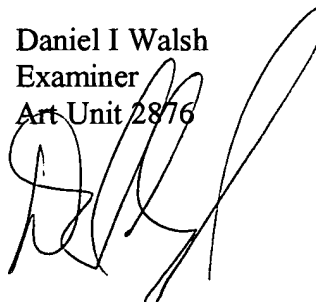
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
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A handwritten signature in black ink, appearing to be 'D. I. Walsh', written over the printed name and title.